

REMARKS

The current Office Action has been reviewed and carefully considered. Claim 15 has been added and claim 4 has been redrafted into independent form. Claims 1-15 are pending in this case, with claims 1, 4, 6 and 8 being the independent claims. The Examiner's indication that claims 6-10 are allowed and of allowable subject matter for claims 4 and 5 is appreciated. Claim 1 has been amended. Reconsideration of the above-identified application in view of the following remarks is respectfully requested.

Claims 1-3 and 11-13 stand rejected under 35 U.S.C. 102(e) as anticipated by U.S. Patent No. 6,393,462 to Mullen-Schultz.

Claim 1 as amended recites "a personalizing means for deriving from said selections personalizing information other than the mere fact that the selected units were selected, in order to store the personalizing information in the second storage device." Support for the amendment of claim 1 is found in the specification (e.g., page 2, lines 3-6).

Mullen-Schultz, by contrast, merely copies a user's bookmark selections from one computer to another. When a Mullen-Schultz user has selected a particular web page by virtue of making a bookmark and then copies the bookmark to another computer, the personalizing information "derived" is limited to the fact that the particular selection has been made. Accordingly, Mullen-Schultz fails to disclose or suggest "a personalizing means for deriving from said selections personalizing information other than the mere fact that the selected units were selected, in order to store the personalizing information in the second storage device" which is explicitly required by the language of claim 1 as

amended. Accordingly, Mullen-Schultz fails to anticipate claim 1 and its dependent claims 2-3 and 11-13.

Claim 14 stands rejected under 35 U.S.C. 103(a) as unpatentable over Mullen-Schultz.

Claim 14 was added in the previous Office Action reply mainly to assure that the current RCE would not be subject to a first Office Action final rejection.

Since claim 14, depends from claim 1, it is deemed to be patentable over the cited reference for at least the same reason as set forth above with regard to claim 1.

The applicants note, however, that this one-reference obviousness rejection apparently attempts to synthesize, from the Mullen-Schultz notion of computer-to-computer transferring of a bookmark, the concept of added functionality for transferring E-mail addresses stored on the source computer to the destination computer. Mullen-Schultz is silent on the subject of E-mail.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." MPEP 2143.01.

Where is the suggestion, other than from impermissible hindsight gained from the reference to e-mail in the present specification and/or the mention of e-mail in claim 14? Nowhere.

Moreover, even if Mullen-Schultz were modified to transfer, in addition, an e-mail address, the added function would not involve “deriving from said selections personalizing information other than the mere fact that the selected units were selected” which is explicitly required by the language of claim 1 and therefore dependent claim 14.

For at least these reasons, Mullen-Schultz fails to render obvious the invention as recited in claim 14.

Claim 15 has been added to more particularly point out what the inventors regard as an aspect of the invention. Claim 15 is supported in the specification (e.g., page 5, lines 24-26).

Claims 4 and 5 were objected to for their dependence from a rejected claim, but were deemed by the Examiner to be allowable if redrafted into independent form. Claim 4 has now been redrafted into independent form, and is deemed allowable. Claim 5 is deemed allowable at least because of its dependence from claim 1 as amended, which has been shown to be allowable.

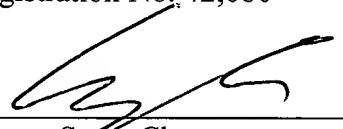
Claims 6-10 have been allowed.

For all the foregoing reasons, it is respectfully submitted that all the present claims are patentable in view of the cited references. A Notice of Allowance is respectfully requested.

Respectfully submitted,

Tony Piotrowski
Registration No. 42,080

Date: 11/26/03


By: Steve Cha
Attorney for Applicant
Registration No. 44,069

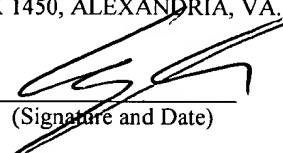
Mail all correspondence to:

Tony Piotrowski, Registration No. 42,080
US PHILIPS CORPORATION
P.O. Box 3001
Briarcliff Manor, NY 10510-8001
Phone: (914) 333-9609
Fax: (914) 332-0615

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Steve Cha, Reg. No. 44,069
(Name of Registered Rep.)


(Signature and Date)